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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,469	11/29/2001	Narayan Solayappan	13176.403	5686

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EXAMINER

PERALTA, GINETTE

ART UNIT

PAPER NUMBER

2814

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/998,469	Applicant(s) SOLAYAPPAN ET AL.	
	Examiner Ginette Peralta	Art Unit 2814	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 16 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-46.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. ☐ Other: _____

SUPP

Continuation of 5. does NOT place the application in condition for allowance because: With regards to applicant's argument that Amanuma discloses combinations of hydrogen barrier layers that have one of the claimed limitations of the materials being both conducting or both insulating and that the primary materials and supplemental materials are different, it is noted that Amanuma discloses in col. 7, lines 4-7 that " a multilayer of Si₃N₄ and SiO₂ or a film containing oxygen and nitrogen represented by SiON... is applicable for the hydrogen barrier film 12", thus Amanuma inherently teaches a hydrogen barrier comprising a multilayer, where the materials are both insulating, and the primary material and the supplemental material are different. With regards to applicant's argument that Shimada et al. uses the strontium tantalate for a different purpose and that using strontium tantalate as a hydrogen barrier layer is not recognized by Shimada et al. it is noted that the fact that Applicant uses the strontium titanate or the silicon oxide for a different purpose does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose disclosed in the reference." In re Lintner, 173 USPQ 560. Furthermore finding a new use for a known material that does not interfere with its previous use does not hinder the use of the material as was previously used, and the newly found use is still inherent to the material as it depends from the characteristics of the material. With regards to the Kanaya reference and the Affidavit filed to show prior invention and diligence, it is noted that the Affidavit will not be considered because good and sufficient reasons why it was not earlier presented have not been shown. The Kanaya reference has been applied before the last office action mailed on 6/16/03 and this issue had never been raised, and the entry of the affidavit would require the examiner to spend significant additional time to conduct another prior art search or revise the Office action (MPEP 714.03(a)). Furthermore, "Affidavits or declarations under 37 CFR 1.131 must be timely presented in order to be admitted. Affidavits and declarations submitted under 37 CFR 1.131 and other evidence traversing rejections are considered timely if submitted: (A) prior to a final rejection; (B) before appeal in an application not having a final rejection; or (C) after final rejection and submitted (1) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or (2) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or (3) under 37 CFR 1.129(a)." (MPEP 715.09). Thus, as the affidavit filed does not satisfy the conditions of being filed after a final rejection and submitted with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, since the Kanaya reference alone and in combination with other references had already being applied to the claims, the Affidavit will not be taken into consideration.